



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/753,860

01/07/2004

Craig D. Cuttner

12510/31

6021

7590
KENYON & KENYON
One Broadway
New York, NY 10004

10/28/2008

EXAMINER

HONG, HYUN J

ART UNIT

PAPER NUMBER

2426

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Regarding claim 1, applicant argues that Ellis in view of McElhatten does not disclose the elements of claim 1. Examiner respectfully disagrees. McElhatten specifically discloses an integrated list that can be used to display recommended titles and recorded programs ([0127]). Ellis discloses a list that can be used to display recommended titles (fig. 16b). As for the argument that Ellis and McElhatten cannot be combined, examiner disagrees. In response to applicant's argument that Ellis cannot be combined with McElhatten, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The user profile of Ellis is meant to generate a listing of programs that fit the criteria of the user's profile. The user profile of Ellis does not exclude a program listing from displaying previously stored programs, as long as they meet the criteria of the user profile. The "MY Shows GUI" of McElhatten (fig. 21) allows the user to find, sort, and manage programs according to the user's own preferences ([0127]), which coincides with the program listing of Ellis.

Regarding claim 20, applicant argues that Hendricks in view of Ellis in view of Dunn does not disclose the elements of claim 20. Examiner respectfully disagrees. In response to applicant's argument that Dunn cannot be combined with Hendricks and

Art Unit: 2426

Ellis, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Hendricks discloses a first list that displays suggested media programs (fig. 16-17). Ellis discloses a second list that displays programs that meet user preferences (fig. 16a, [0095]). The Dunn reference discloses a combined listing in which two separate lists are displayed, with a demarcation. It would be obvious to display the two lists in the format represented by Dunn in order to provide convenience to the user by showing two lists simultaneously in a clear manner.

/H. J. H./

Examiner, Art Unit 2426